

REMARKS

Applicant respectfully requests reconsideration of this application as amended.

Claims 1-33 and 36-39 are pending in this application.

Claims 1-4, 7, 9-14, 17, 19-21, 23-27, 29-31, 33 and 35 were provisionally rejected as being unpatentable over co-pending Application No. 09/865,919 under the judicially created doctrine of obviousness-type double patenting.

Claims 1, 3-7, 10-11, 13-17, 20-30, 34-36 and 38 were rejected under 35 U.S.C. §102(e) as being considered anticipated by U.S. Patent Application Publication 2003/0046421 of a patent application filed by Horvitz et al (hereinafter referred to as "Horvitz").

Claims 2, 12, 37 and 39 were rejected under 35 U.S.C. §103(a) as being considered unpatentable over Horvitz, in view of well known prior art.

Claims 8-9, 18-19, 22 and 33 were rejected under 35 U.S.C. §103(a) as being considered unpatentable over Horvitz, alone.

Claims 34-35 have been cancelled.

Claims 1-9, 11-19, 21-33, 37 and 39 have been amended.

No claims have been added.

Provisional Obviousness-Type Double Patenting Rejection  
of Claims 1-4, 7, 9-14, 17, 19-21, 23-27, 29-31, 33 and 35

The Examiner has provisionally rejected claims 1-4, 7, 9-14, 17, 19-21, 23-27, 29-31, 33 and 35 as being unpatentable over co-pending Application No. 09/865,919, under the judicially created doctrine of obviousness-type double patenting based on a policy of preventing unjustified or improper timewise extension of the "right to exclude" and possible harassment of others by multiple assignees. As suggested by the Examiner, Applicant has provided a terminal disclaimer, herewith, to overcome this rejection.

35 U.S.C. §102(e) Rejection of Claims 1, 3-7, 10-11, 13-17, 20-30, 34-36 and 38

The Examiner has rejected claims 1, 3-7, 10-11, 13-17, 20-30, 34-36 and 38 under 35 U.S.C. §102(e) as being considered to be anticipated by Horvitz. Applicant has cancelled

claims 34-35, thereby obviating this rejection with regard to these claims. Still, Applicant respectfully submits that none of claims 1, 3-7, 10-11, 13-17, 20-30, 36 and 38 are anticipated by Horvitz, because Horvitz does not teach each and every element of Applicant's invention as claimed.

Regarding independent claims 1, 11, 21 and 27, the Office Action asserts that Horvitz discloses constructing computer instructions to take action without contacting any person if an event has a level of importance greater than a first threshold and below a second threshold. However, Applicant respectfully submits that Horvitz does not disclose any instance of taking any form of action without contacting any person that entails a monetary exchange, i.e., making a payment to an e-commerce provider. A reading of Horvitz reveals that Horvitz teaches only trying to contact the user, or possibly, trying to contact the sender of an email that is, itself, the event. For at least these reasons, Applicant respectfully submits that claims 1, 11 and 34 are patentably distinguished over Horvitz.

Regarding claims 4-5 and 14-15, these claims depend from independent claims 1 and 11, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz.

Regarding independent claims 7, 17, 26 and 30, these claims depend from independent claims 1, 11, 21 and 27, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz. Also, the Office Action asserts that Horvitz discloses constructing computer instructions to refer to user's preferences to determine if it is preferred that action be taken without contacting any person. However, Applicant respectfully submits that Horvitz does not disclose any instance of referring to preferences to determine whether taking action without contacting anyone would require paying too high a price. As mentioned earlier, a reading of Horvitz reveals that Horvitz teaches only trying to contact the user, or possibly, trying to contact the sender of an email that is, itself, the event. For at least these reasons, Applicant respectfully submits that claims 7, 17, 26 and 30 are patentably distinguished over Horvitz.

Regarding claims 10 and 20, these claims depend from independent claims 1 and 11, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz.

Regarding claims 36 and 38, these claims depend from independent claims 21 and 27, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz.

In view of the foregoing arguments, Applicant respectfully asserts that claims 1, 3-7, 10-11, 13-17, 20-30, 34-36 and 38 are in condition for allowance.

35 U.S.C. § 103(a) Rejection of Claims 2, 12, 37 and 39

The Examiner has rejected claims 2, 12, 37 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Horvitz, in view of well known prior art.

Regarding claims 2 and 12, these claims depend from independent claims 1 and 11, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz.

Regarding claim 37 and 39 Applicant notes that although this claim was included in the list of those rejected as unpatentable over Horvitz in view of well known prior art, it seemed to be errantly included among the detail for 103(a) rejections based on Horvitz, alone. Regardless, claims 37 and 39 depend from independent claims 21 and 27, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz.

Applicant respectfully asserts that claims 2, 12, 37 and 39 are in condition for allowance.

35 U.S.C. § 103(a) Rejection of Claims 8-9, 18-19, 22 and 33

The Examiner has rejected claims 8-9, 18-19, 22 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Horvitz, alone.

Regarding claims 8-9, 18-19, 22 and 33, these claims depend variously from independent claims 1, 11, 21 and 27, which Applicant has previously asserted are patentably distinguished over Horvitz.

Applicant respectfully asserts that claims 8-9, 18-19, 22 and 33 are in condition for allowance.

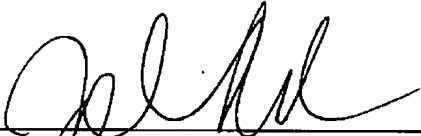
Condition for Allowance

Applicant submits that all rejections have been overcome and the present application is now in condition for allowance. If there are any additional charges or shortages related to the present communication, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: September 20, 2004

  
\_\_\_\_\_  
John Patrick Ward  
Registration No. 40,216

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1030  
(408) 720-8300